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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/336,103 06/18/99 DOWNS K 960296.95912

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HM12/0905

EXAMINER

CLARK, D

ART UNIT

PAPER NUMBER

1633

DATE MAILED:

09/05/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/336,103

Applicant(s)

Downs, Karen M.

Examiner

Deborah Clark

Group Art Unit
1633



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-23 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-23 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-9, 16, and 18, drawn to a method of fetal gene therapy via a chimeric allantois/umbilical cord, classified in class 424, subclass 93.1.
 - II. Claims 10-13, drawn to a method of fetal gene therapy via a chimeric fetal organ, classified in class 424, subclass 93.1.
 - III. Claims 14, 17, 19, and 20, drawn to a method of observing vasculogenesis in culture, classified in class 435, subclass 325+.
 - IV. Claim 15, drawn to a transgenic allantois, classified in class 435, subclass 325+.
 - V. Claims 21-23, drawn to a method of evaluation using a composition comprising transgenic allantois and mesenchymal cells, classified in class 435, subclass 4+.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are distinct because they are directed to divergent methods of fetal gene therapy. Each method has different steps and is accomplished using different methodology.

Inventions I and II, III, and V are distinct because the inventions are directed to divergent methods. Each method has a different goal and is accomplished using different steps and methodology.

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Inventions I or II and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product of group V can be used in materially different processes and the process of groups I or II does not require the product of group V.

Inventions III or V and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product of group IV can be used in materially different processes as represented by groups I, II, III, and V.

3. Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, and require different searches, restriction for examination purposes as indicated is proper.


4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Clark whose telephone number is (703) 305-4051. The examiner can normally be reached on Mondays-Fridays from 7:10 a.m. EST to 3:40 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader, can be reached on (703) 308-0447. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


DEBORAH J.R. CLARK
PRIMARY EXAMINER